

## **REMARKS**

Claims 1-4, 6-15, 17-18 and 21-30 are pending in the application.

Claim 1 is amended above to clarify that the claimed method is performed on a human “in need thereof”.

The examiner’s claim rejections are overcome or they are traversed as set forth below.

### **I. THE DOUBLE PATENTING REJECTIONS**

The examiner has rejected application claims for double patenting and for provisional double patenting over commonly owned U.S. patents and patent application.

#### **A. The Provisional Double Patenting Rejection**

The examiner provisionally rejected application claims for double patenting over co-pending application serial numbers 10/766,043; 11/070,768; 11/253,322; and 11/588,834.

All four of the cited applications having filing dates after the filing date of the above-identified patent application. MPEP 804(I)(B)(1) indicates that when the provisional obviousness-type double patenting (PODP) rejection is the only rejection remaining in the earlier filed application, or if the PODP rejection is the only rejection remaining in the earlier and later filed applications, then the examiner should withdraw the PODP rejection in the earlier filed application and allow the earlier filed application to issue without a terminal disclaimer. Since that is the case here, the examiner should withdraw the PODP rejection and allow the current application to issue without a terminal disclaimer directed to the later filed co-pending patent applications.

#### **B. The Non-Provisional Double Patenting Rejections**

The examiner rejected claims of this application for double patenting over commonly owned U.S. patent nos. 6,403,567; 6,642,210; 7,144,872; and 7,183,264.

While disagreeing with the examiner’s double patenting rejection, the Applicant, in an effort to expedite allowance of this application has filed a Terminal Disclaimer of each of the listed patents. A copy of the Terminal Disclaimer is included at Appendix A of this Reply.

### **II. THE ALLEGED CONFLICTING CLAIMS**

The examiner has taken the position that claims 1-15, 17-18 and 20-30 of this application conflict under 37 CFR §1.78(b) with claims of co-pending patent application nos. 10/766,403;

11/070,768; 11/253,322; and 11/588,834 and that the elimination of such claims from all but one application may be required in the absence of good and sufficient reasons for their retention during pendency in more than one application. The examiner goes on to require the Applicant to cancel the conflicting claims or to maintain a clear line of demarcation between the applications.

As an initial matter, the Applicant disagrees with the examiner's position that the applications include "conflicting claims." None of the claims are identical, and all of the claims of the different applications are patentably distinct from one another. In addition, the Applicant intends to maintain a clear line of demarcation between the applications and their claims. For at least these reasons, the examiner's position that the applications include "conflicting claims" is traversed.

### **CONCLUSION**

Applicants submit that the claims are in condition for allowance. A Notice of Allowance is requested, and a prompt mailing thereof would be much appreciated. Should the Examiner have any questions, he is invited to contact the undersigned attorney at (312) 913-2123.

Respectfully submitted,

McDonnell Boehnen Hulbert & Berghoff LLP

Date: October 23, 2008

By: /A. Blair Hughes/  
A. Blair Hughes  
Reg. No. 32,901  
(312) 913-2123

# **APPENDIX A**

**(Terminal Disclaimer Copy)**

**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE  
PATENTING REJECTION OVER A "PRIOR" PATENT**

Docket No. 02-479-C

In Re Application of: Belardinelli

Application No.: 10/629,368

Filed: July 29, 2003

For: Myocardial Perfusion Imaging Method

The owner, CV Therapeutics, Inc. of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term of prior patent No. 6,403,567 (Zablocki '567) as the term of Zablocki '567 is defined in 35 U.S.C. 154 and 173, and as the term of Zablocki '567 is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and Zablocki '567 are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of Zablocki '567, "as the term of any said prior patent is presently shortened by any terminal disclaimer," in the event that said Zablocki '567 later:

- expires for failure to pay a maintenance fee;
- is held unenforceable;
- is found invalid by a court of competent jurisdiction;
- is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
- has all claims canceled by a reexamination certificate;
- is reissued; or
- is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

In addition, the owner, CV Therapeutics, Inc. of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term of prior patent No. 6,642,210 (Zablocki '210) as the term of Zablocki '210 is defined in 35 U.S.C. 154 and 173, and as the term of Zablocki '210 is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and Zablocki '210 are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of Zablocki '210, "as the term of any said prior patent is presently shortened by any terminal disclaimer," in the event that said Zablocki '210 later:

- expires for failure to pay a maintenance fee;
- is held unenforceable;
- is found invalid by a court of competent jurisdiction;
- is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
- has all claims canceled by a reexamination certificate;
- is reissued; or
- is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE  
PATENTING REJECTION OVER A "PRIOR" PATENT**

Docket No. 02-479-C

In addition, the owner, CV Therapeutics, Inc. of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term of prior patent No. 7,144,872 (Zablocki '872) as the term of Zablocki '872 is defined in 35 U.S.C. 154 and 173, and as the term of Zablocki '872 is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and Zablocki '872 are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of Zablocki '872, "as the term of any said prior patent is presently shortened by any terminal disclaimer," in the event that said Zablocki '872 later:

- expires for failure to pay a maintenance fee;
- is held unenforceable;
- is found invalid by a court of competent jurisdiction;
- is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
- has all claims canceled by a reexamination certificate;
- is reissued; or
- is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

In addition, the owner, CV Therapeutics, Inc. of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term of prior patent No. 7,183,264 (Zablocki '264) as the term of Zablocki '264 is defined in 35 U.S.C. 154 and 173, and as the term of Zablocki '264 is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and Zablocki '264 are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of Zablocki '264, "as the term of any said prior patent is presently shortened by any terminal disclaimer," in the event that said Zablocki '264 later:

- expires for failure to pay a maintenance fee;
- is held unenforceable;
- is found invalid by a court of competent jurisdiction;
- is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
- has all claims canceled by a reexamination certificate;
- is reissued; or
- is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization. Further, under 37 CFR 3.73(b), the undersigned certifies that CV Therapeutics, Inc. is the assignee of record of the entire interest in this application, by virtue of an assignment from the inventor(s) of the application, recorded in the U.S. Patent and Trademark office at Reel 014697, Frame 0904.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

<b>TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER A "PRIOR" PATENT</b>		Docket No. 02-479-C
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Signed: /A. Blair Hughes/		October 23, 2008
A. Blair Hughes Reg. No. 32,901 McDonnell Boehnen Hulbert & Berghoff LLP 300 S. Wacker Drive Chicago, IL 60606 Telephone: (312) 913-2123		Date
<input checked="" type="checkbox"/> Please charge the terminal disclaimer fee (\$140.00) under 37 CFR 1.20(d) to Deposit Acct. 132490.		